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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,584	05/16/2001	Thomas M. Collins	2280.2700	1405
26211 7590 06/15/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BATURAY, ALICIA	
			ART UNIT 2155	PAPER NUMBER
			MAIL DATE 06/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/855,584

Applicant(s)

COLLINS ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 17, 23, 29 and 40-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 17, 23, 29 and 40-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02072007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), which was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 March 2007 has been entered.
2. Claims 6, 17, 23 and 29 were amended.
3. Claims 1-5, 7-16, 18-22, 24-28 and 30-39 were cancelled.
4. Claims 52-71 were added.
5. Claims 6, 17, 23, 29 and 40-71 are pending in this Office Action.

Response to Amendment

6. Applicant's amendments and arguments with respect to claims 6, 17, 23 and 29 and new claims 52-71 filed on 30 March 2007 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 17, 23, 29, 40-42, 44-46, 48-50, 52-55, 57-60, 62-65 and 67-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (U.S. 6,311,210) in view of Redpath (U.S. 6,256,672) and further in view of Beck et al. (U.S. 5,903,723).

Foladare teaches the invention substantially as claimed including when a sending party wishes to send an electronic mail message to a receiving party, the sending party creates the electronic mail message along with any attachments using his/her user device and sends the electronic mail message to the centralized electronic mail apparatus. The centralized electronic mail apparatus further determines the portions of the electronic mail message that are to be sent to each of the electronic mail receiving devices (see Abstract).

9. With respect to claim 6, teaches an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations: enable a sender to input a message; enable the sender to append an attachment to the message; enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment (Foladare, col. 3, lines 5-14); enable a recipient to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (Foldare, col. 6, 1 lines 8-17); and transmit the message over a network from the sender to the plurality of

recipients, wherein (Foldare, col. 3, lines 5-14) the message is transmitted without the attachment to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment (Foldare, col. 6, lines 21-40).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

The combination of Foldare and Redpath does not explicitly teach transmission of the message from the sender without the attachment.

However, Beck teaches the message is transmitted from the sender without the attachment (Beck, col. 5, lines 39-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare and Redpath in view of Beck in order to enable transmission of the message from the sender without the attachment. One would be

motivated to do so in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network.

10. With respect to claim 40, Foldare teaches the invention described in claim 6, including the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies information about prospective attachments that the recipient is unable, or does not wish, to receive (Foldare, col. 6, lines 8-17 and lines 21-40).
11. With respect to claim 41, Foldare teaches the invention described in claim 40, including the article including instructions that, when executed by the machine, cause the machine to prevent recipient by the recipient of the prospective attachments that the recipient's profile indicates the recipient is unable, or does not wish, to receive (Foldare, col. 6, lines 8-17 and lines 21-40).
12. With respect to claim 42, Foldare teaches the invention described in claim 41, including the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies the recipient is not to receive attachments larger than a specified size (Foldare, col. 6, lines 8-17 and lines 21-40).
13. With respect to claim 52, Foldare teaches an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the

machine to perform the following operations: enable a sender to input a message; enable the sender to append an attachment to the message; enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment (Foldare, col. 3, lines 5-14); enable a recipient to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (Foldare, col. 6, lines 8-17); and transmit the message over a network from the sender to the plurality of recipients, wherein (Foldare, col. 3, lines 5-14) the message is transmitted without the attachment to any recipient whose reception profile specifies not to receive an attachment, even though the sender designated that recipient to receive the message with the attachment (Foldare, col. 6, lines 21-40).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

The combination of Foldare and Redpath does not explicitly teach transmission of the message from the sender without the attachment.

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However, Beck teaches the message is transmitted from the sender without the attachment (Beck, col. 5, lines 39-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare and Redpath in view of Beck in order to enable transmission of the message from the sender without the attachment. One would be motivated to do so in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network.

14. Claims 17, 23, 29, 44-46, 48-50, 53-55, 57-60, 62-65 and 67-70 do not teach or define any new limitations above claims 6, 40-42 and 52 and therefore are rejected for similar reasons.
15. Claims 43, 47, 51, 56, 61, 66 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foldare in view of Redpath in view of Beck and further in view of Ulrich et al. (U.S. 6,052,735).
16. With respect to claim 43, Foldare teaches the invention described in claim 41, including an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations: enable a sender to input a message; enable the sender to append an attachment to the message; enable the sender to designate at least one recipient of a plurality of recipients to

receive the message and the attachment (Foldare, col. 3, lines 5-14); enable a recipient to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (Foldare, col. 6, lines 8-17); and transmit the message over a network from the sender to the plurality of recipients, wherein (Foldare, col. 3, lines 5-14) the message is transmitted without the attachment to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment (Foldare, col. 6, lines 21-40).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

The combination of Foldare and Redpath does not explicitly teach transmission of the message from the sender without the attachment.

However, Beck teaches the message is transmitted from the sender without the attachment (Beck, col. 5, lines 39-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare and Redpath in view of Beck in order to enable transmission of the message from the sender without the attachment. One would be motivated to do so in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network.

The combination of Foldare, Redpath and Beck does not explicitly teach a profile that specifies that a recipient is not to receive attachments during a particular time.

However, Ulrich teaches the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies the recipient is not to receive attachments during a particular time frame (Ulrich, col. 13, lines 12-16):

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare, Redpath and Beck in view of Ulrich in order to enable a profile that specifies that a recipient is not to receive attachments during a particular time. One would be motivated to do so in order to allow the user of a mobile device to dynamically retrieve individual electronic mail message attachments on a per message basis.

17. Claims 47, 51, 56, 61, 66 and 71 do not teach or define any new limitations above claim 43 and therefore are rejected for similar reasons.

Response to Arguments

18. Applicant's arguments filed 30 March 2007 have been fully considered, but they are not persuasive for the reasons set forth below.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at M-Th 7:15 - 5pm, 2nd Fridays 7:15-3:45, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
June 6, 2007


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER